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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,139	03/06/2007	Shinichiro Yamada	09792909-6492	2702

26263 7590 04/27/2009  
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EXAMINER
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LEE, DORIS L

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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04/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Attachment to Advisory Action***

1. Applicant's response filed February 12, 2009 has been fully considered but is not persuasive for the reasons set forth below.

2. **Applicant's argument:** Applicant requests that the double patenting rejection be withdrawn.

**Examiner's response:** *As the applicant has not presented any argument to overcome the double patenting rejection, the rejection will be maintained.*

3. **Applicant's argument:** Yamada teaches a biodegradable resins with a flame retardant additive and a hydrolysis inhibitor. Yoshida teaches a nitrogen oxide as a flame retardant. However, the claims require both a hydroxide and nitrogen oxide compound.

**Examiner's response:** *In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).*

4. **Applicant's argument:** The hydroxide and the nitrogen oxide compound act synergistically when high heat is applied to the resin and therefore the combination produces unexpected results. Applicant refers to Table 2 for the supporting data.

**Examiner's response:** *Regarding applicant's claim of unexpected results, the examiner has considered the data in the specification; it does not appear that unexpected results are apparent. When the data in Table 2 is compared to the data in*

*Table 1, the effect of adding the nitrogen oxide compound to the composition does not change the UCL94C-1 performance of the composition, therefore the synergistic effect that the applicant claims is not supported by the data. Also, none of the comparative data in Table 2 shows the flame retardancy of only the nitrogen oxide compound; therefore the synergistic effect between the hydroxide and the nitrogen oxide composition cannot properly be ascertained.*

*It is also noted that the data presented is not commensurate in scope to the claimed invention. The data shown in Table 2 is much narrower than the scope of the claimed invention. For example, the instant claim generically claims a "biodegradable polysaccharide", however, the data shows information for only acetyl cellulose and esterified starch; the instant claim generically claims "a hydrolysis suppressing agent", however, the data shows information for only a specific type of hydrolysis suppressing agent – namely Carbodilite HMV-8CA; the instant claim generically claims a hydroxide and a nitrogen oxide compound, however, the data shows information for only aluminum hydroxide and ammonium nitrate.*

5. **Applicant's argument:** The data in Table 2 indicates better flame retardant performance than either Yamada or Yoshida alone.

**Examiner's response:** *In response to the applicant's argument that the data in Table 2 shows improved UCL94C-1 performance over either Yamada or Yoshida, it is noted that the rejection is over the two references in combination, not over each singly.*

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6. **Applicant's argument:** It would not have been obvious to combine Yoshida and Yamada in order to achieve better UL94C results because each of the cited reference teaches examples that exhibit flame retardant properties of only SL94V-2.

**Examiner's response:** *The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).*

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Doris L Lee/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796